

REMARKS

The Office Action mailed Dec. 27, 2005 objected to the claims. Claims 1 and 11 were rejected under 35 U.S.C. § 102(e) as anticipated by Byrne (US 20050060235 A2). Claims 2 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne in view of McLauchlin (US 6754672 B1). Claims 3-5 and 13-15 are rejected under 35 U.S.C. §103(a) as unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12, and further in view of King, Jr. et al. (US 5319542, herein referred to as King). Claims 6-8 and 16-18 were rejected under 35 U.S.C. 103(a) as unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12, and further in view of Gieselmann et al. (US 20040117263 A1, herein referred to as Gieselmann). Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16 above, and further in view of Goodman et al. (US 20030088475 A1, herein referred to as Goodman). Claims 10 and 20 were rejected under 35 U.S.C. 103(a) as unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16, and further in view of King and Muscavage, III et al. (US 20030126036 A1, herein referred to as Muscavage).

The Section 112 Rejections

The Office Action objected and rejected certain claims. The claims have been amended. Withdrawal of the objection/rejection is requested.

The Section 102 Rejection

Claims 1 and 11 were rejected under 35 U.S.C. § 102(e) as anticipated by Byrne. Byrne relates to a server acting as the hub of a collaborative commerce system. Suppliers of goods or services self publish information to the hub. Buyers are able to query the hub

for product and service availability, price etc. Buyers are able to integrate real time multi product and multi service orders from multiple suppliers, carriers and field serve providers and thus secure available goods as well as the delivery and installation of those goods from the records available on the hub. Once an order is complete to the buyer's satisfaction, the order is transmitted to the hub. The hub then transmits the appropriate information to the relevant suppliers, carriers and installers as required. The system also provides for a system of virtual partitioning of a supplier's inventory.

Applicants respectfully traverse the rejection. Byrne does not disclose in full a system to support an electronic market place with a communication network to communicate purchase requests; one or more buyers coupled to the network to issue a purchase order specifying items from two or more suppliers; and a server coupled to the network to receive the purchase order, the server accessing a Central Contract Registry (CCR) for supplier data and generating sub-orders from the purchase order and sending the sub-orders to the two or more suppliers for fulfillment and paying the suppliers based on CCR data.

As a Section 102 rejection requires each and every element be present, Applicants submit that the Section 102 rejection is inappropriate and request withdrawal of the Section 102 rejection.

The Section 103 Rejection

Before Applicants respond, a review of the requirement for a *prima facie* case of obviousness is helpful. Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Turning now to the rejection, Claims 2 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne in view of McLaughlin (US 6754672 B1). The Office Action noted that:

Byrnes discloses:

receiving an acceptance from the vendor (at least paragraph [0052]; vendor acknowledges order and ships product)

Byrne does not disclose:

accessing data from a Central Contract Registry (CCR) Database to retrieve vendor payment data

paying the vendor using the CCR database

McLauchlin teaches that it is known to include accessing the Central Control Registry Database to retrieve vendor data (at least column 1, lines 43-64: agent uses CCR to retrieve vendor data) and paying the vendor using the data (at least column 1, lines 43-64: agent finalizes order) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the accessing of the CCR Database to retrieve vendor payment data and paying a vendor using that data, as taught by McLauchlin, since such a modification would have provided a way to integrate government systems to the into the public sector to aid procurement systems (at least column 1, lines 22-42 of McLauchlin).

McLauchlin's Col. 1, lines 43-64 discloses that vendor data may be stored in a CCR system as follows:

Each system provides value to the corresponding federal organization in automating the individual processes and functions for which they are designed. However, the functions of these systems often overlap, or need to interoperate. Consider the simple example of buying a desk. A procurement system generates the purchase order, but the procurement process requires interoperability with several other systems. For instance, the purchasing agent may desire to post solicitation information to FedBizOpps to solicit bids. Further, as part of the procurement decision process, the purchasing agent is required to consider the past performance of potential vendors, for example, by accessing past performance systems such as the NIH past performance system. The purchasing agent may require additional detailed vendor data, which may be stored in a CCR system. Further, before an order is finalized, the organization's financial system needs to be polled to ensure that funds are available in the budget for the purchase and to obligate money for the ensuing payment. The purchasing agent may also need to report order data to FPDS. A property manager may also want to track the newly purchased item as a fixed asset in a property management system.

Applicants respectfully traverse the rejection. McLauchlin discloses that the purchasing agent may require additional detailed vendor data, which may be stored in a CCR system. However, neither Byrne nor McLauchlin singly or in combination teaches or suggests a system to support an electronic market place with a communication network to communicate purchase requests; one or more buyers coupled to the network to issue a purchase order specifying items from two or more suppliers; and a server coupled to the

network to receive the purchase order, the server accessing a Central Contract Registry (CCR) for supplier data and generating sub-orders from the purchase order and sending the sub-orders to the two or more suppliers for fulfillment and paying the suppliers based on CCR data.

Combining Byrne with McLauchlin would not result in the claimed system. McLauchlin's objective is to provide for a system that allows internal government systems (e.g., program systems including customer relationship management, internal operations, and administrative systems including finance, procurement, property, asset sales, and grants) and external government systems (e.g., FedBizOpps, CCR, FPDS or the Federal Acquisition Management Information System) to communicate and exchange messages and allows an end user to access the plurality of disparate legacy, current, and emerging government application systems from a point of entry web-based portal in a computer communications network. Thus, the combined system would allow the purchasing agent to post solicitation information to FedBizOpps to solicit bids or to access past performance systems such as the NIH past performance system or may view detailed vendor data, which may be stored in a CCR system or to check that funds are available in the budget for the purchase and to obligate money for the ensuing payment or to report order data to FPDS or to track the newly purchased item as a fixed asset in a property management system.

However, the combination would suggest that the purchasing can view CCR data as part of his or her purchasing decision. However, the combination fails to teach automatically using CCR data as part of the sub-order processing and payment. Hence, there is no teaching or suggestion to modify Byrne to arrive at the invention as claimed.

There is no reasonable expectation of success since the needs of viewing data from various sources differ from the needs of automatically ordering and paying multiple vendors using CCR data.

Byrne and McLauchlin take mutually exclusive paths and reaches different solutions to a different problem than the claimed invention. Here, it would be necessary to make modifications not taught in the prior art in order to modify the prior art in the manner suggested since McLauchlin teaches human viewing of CCR data and not automated processing of CCR data to order and to pay vendors. As McLauchlin teaches away from the invention, it would not be obvious to modify Byrne to arrive at the invention as claimed.

The evidence shows that the reference used to reject the claims teaches away from the claimed invention since the proposed combination would render the construction of the references impracticable for their intended purposes and the combination would be uneconomical and unreliable. This teaching away is a per se demonstration of lack of *prima facie* obviousness. The teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. In re Fine, 873 F.2d 1021 (Fed. Cir. 1988).

The rebuttal evidence also shows that there is no basis in the art for combining the references in the manner proposed. Per MPEP Section 2143.01:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In *In re Kotzab*, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one system may be used to control a number of valves. The court found that there was insufficient evidence to show that one system was the same as one sensor. While the control of multiple valves by a single sensor rather than by multiple sensors was a "technologically simple concept," there was no finding "as to the specific understanding or principle within the knowledge of the skilled artisan" that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

In *In re Fine*, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

The instant case is similar to *In re Fine* in that the Office Action asserted that it would have been within the skill of the art to substitute viewing of CCR with using CCR to order and to pay in the system of the primary reference. In this case, there was no support or explanation of this conclusion and the rejection should be withdrawn.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The evidence also noted that the combination of references proposed in the Office Action would render the construction of the references impracticable for their intended purposes. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, there is no motivation to combine.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or

motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The evidence also indicates that there was no reasonable expectation of success when combining the references. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (Claims directed to a method for the commercial scale production of polyesters in the presence of a solvent at superatmospheric pressure were rejected as obvious over a reference which taught the claimed method at atmospheric pressure in view of a reference which taught the claimed process except for the presence of a solvent. The court reversed, finding there was no reasonable expectation that a process combining the prior art steps could be successfully scaled up in view of unchallenged evidence showing that the prior art processes individually could not be commercially scaled up successfully.). See also *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991) (In the context of a biotechnology case, testimony supported the conclusion that the references did not show that there was a reasonable expectation of success.); *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

As Byrne or McLauchlin, singly or in combination, does not teach or suggest all the claim limitations in the independent claims, they also fail as to each dependent claim. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Byrne, there is an inference that it came from Applicants' disclosure. Thus, Byrne and McLauchlin cannot render obvious this independent claim and those claims dependent therefrom.

In addition, each dependent claim is patentable over the cited art. Claims 3-5 and 13-15 were rejected under 35 U.S.C. §103(a) as unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12, and further in view of King. King teaches an Electronic Catalogue includes a Public Catalog and a Private Catalogue. The Public Catalog is stored on a publicly available database for access by customer/Requestors. The Private Catalogue is resident on a Customer's computer system and may contain unique pricing data based on pricing agreements.

First, as to claim 3, King's claim 13 for "downloading the catalog database to a Customer/Requestor computer system; modifying said catalog database to create a private catalog, said private catalog containing data different than said downloaded catalog database;" does not show the instant claim 3's keeping a local copy of the CCR database in a system database.

As to claim 4, the King private catalog does not correspond to the instant claim 4's importing the CCR data into a public data storage and a private data storage. Here, in one implementation discussed on pages 16-17 of the Specification, the "CCR public data and private data are retrieved from the system database 360. The public data is used to determine the vendor's business name and mailing address (400). The private data is

used to determine the vendor's EFT information such as Routing Number and Account number, among others (402). The contact information and bank information (vendor payment information) is provided to an accounting system (in this embodiment a Costpoint system) through an interface 410." Hence, public and private information are not duplicates of each other. In contrast, King's private database is a modification of the public database. As to claim 5, it is allowable as it depends from allowable claim 1. The corresponding claims are also allowable. Withdrawal of the rejection of these dependent claims is requested.

Claims 6-8 and 16-18 were rejected under 35 U.S.C. 103(a) as unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12, and further in view of Gieselmann. Gieselmann discloses steps for the initial registration of the company by one of its employees. In step 63 the registration control program 6 prompts the user to input company specific data and an unique company ID. For example the VAT-Number of the company i can be utilized as a unique identifier or the DUNS-Number of the company. The DUNS (a unique number assigned by Dun & Bradstreet Corp.) number can be validated using Dun & Bradstreet Corp. Modulus Ten Check Digit. algorithm for the ninth digit. However, Gieselmann's DUNS numbers do not correspond to the claimed CCR as the CCR contains information not available in DUNS and thus the combination is inappropriate. Withdrawal of the rejection of these dependent claims is requested.

Claims 9 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16 above, and further in view of Goodman, which shows a a remote transactional and tracking software protocol which is able to transfer the purchase and tracking transactions from one Internet

site, a retail site, to another Internet site, the referring or "host" site, the latter operating as a virtual retail site. Using this protocol, the owner of a web browser or content site can sell items over the Internet without storing, stocking or shipping the items. Using a listing of products or services for sale, the content site owner transfers prospective purchasers who visit the content site to a retail site for inspection of the goods and to acquire additional information about the retailer's products. However, upon the commencement of a transaction on the retailer's site, the protocol routs the financial information and payment to the content (or referring) site, while separating and sending the delivery information to the retail site. However, Goodman and the other references do not show the specifics of claim 1 or 11, further do not show using the CCR data to Register Vendors, Search and Select Vendors for solicitation of services and/or delivery of supplies; View Vendor Profile; Search Vendor Profile; or Electronically Transfer Funds for outstanding account payable as well as receiving as a search parameter one or more of the following: Business Name; DUNS and CAGE Code; Socio Economic Factors; Business Type; Geographic Location; and NAICS/SIC Code. Withdrawal of the rejection of these dependent claims is requested.

Claims 10 and 20 were rejected under 35 U.S.C. 103(a) as unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16, and further in view of King and Mascavage. Mascavage shows funds transfers between the user and FTS accounts and between the FTS and merchant accounts during a purchase. However, the references do not show the specific elements and their relationship of


means for retrieving CCR public data and private data;

means for determining the vendor's business name and mailing
address from the public data;
means for determining the vendor's electronic fund transfer (EFT)
information from the private data; and
means for using the EFT information to pay the vendor.

In sum, none of the references can render independent claims 1 and 11
unpatentable, and similarly cannot render any of the dependent claims unpatentable.

If the Examiner believes a telephone conference would expedite prosecution of
this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,


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